

Application No. 10/698,883
Filed: 10/31/2003

REMARKS

At the time of the Office Action dated May 20, 2005, Claims 1-56 were pending in this application. Claims 1-7, 9-11, 22-30, 33, 34 and 36-44 are currently pending and are now presented for examination. Claims 1, 9, 22, 29, 33, 36, and 39-44 have been amended, and Claims 8, 12-21, 31, 32, 35 and 45-56 have been cancelled without prejudice and without disclaimer of subject matter. No new subject matter has been added. Claims 1, 22 and 29 are independent.

Specifically, Claim 1 has been amended by incorporating certain of the features recited in Claims 9 and 12 and to recite obtaining alarm event information inputted into an alarm event logging unit (ALU) by a user. Claim 22 has been amended to include the features previously presented in Claims 1 and 35 and to clarify that alarm event information is inputted by a user into an ALU. Claim 29 has been amended to be placed in independent form. Claims 9, 33, 36, and 39-44 have been amended to address dependency issues arising from the cancellation of Claims 8, 31, and 35.

In paragraph 3 of the Office Action, Claims 1-12, 22-29, 31-36 and 44 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,745,036 ("Clare"). On pages 2-5 of the Office Action, the Examiner asserted that Clare discloses a methodology and system corresponding to that Claimed. This rejection is respectfully traversed. The patentability of independent Claims 29, 22 and 1 are described as follows:

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Independent Claim 29

Claim 29 has been amended to be placed in independent form by including all the features recited in Claims 22 and 27-28, upon which originally-presented dependent Claim 29 depended. Claim 29 recites, in part, that "the POS device is further operable to obtain EAS tag information upon deactivation of the EAS tag." The first paragraph on page 5 of the Office Action cites column 9, lines 15-58 of Clare as disclosing this particular feature. Applicants respectfully disagree that this cited portion of Clare identically discloses the above-reproduced features.

A review of the citation relied upon in the Office Action yields teachings of articles tagged with intelligent RF-ID security tags 22 and conventional physically deactivatable resonant security tags (column 9, lines 19-20) and that during a purchase transaction, a salesperson physically deactivates the convention security tag (column 9, lines 31-32). However, this citation is silent as to a POS device obtaining EAS tag information upon deactivation of an EAS tag, as recited in Claim 29. Therefore, Clare fails to identically disclose the claimed invention, as recited in amended Claim 29, within the meaning of 35 U.S.C. § 102. Claim 29 is believed patentable for at least this reason and the withdrawal of the rejection of Claim 29 is earnestly solicited.

Independent Claim 22

Independent Claim 22 has been amended to include the features previously presented in Claims 31 and 35. Specifically, these Claims recite an EAS device that includes an alarm event logging unit (ALU). The ALU receives an alarm event and generates EAS data based upon the alarm event and alarm event information. In this regard, Applicants note that the alarm event is

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separate from the alarm event information. Claim 22 has also been amended to clarify that the alarm event information is inputted by a user into the ALU.

In the fourth paragraph on page 5 of the Office Action with regard to Claim 35, the Office Action states that:

Regarding Claims 35-36, Clare discloses EAS device providing data to an event database (46) subsequently comparing the data with the transaction/POS database (40) and generating a discrepancy report based thereon.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the office action must (a) identify the elements of the Claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. This burden has not been met. Moreover, the Office Action fails to clearly designate the teachings in Clare being relied upon. In this regard, the rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).¹

The Office Action fails to identify any feature in Clare that corresponds to the claimed ALU, previously recited in Claim 35 and now recited in Claim 22. In fact, the Office Action does not even recognize an ALU in the statement of the rejection. Referring to Fig. 1 of Clare, encoded RF-ID data 44 is sent directly from the interrogator 42 to the transaction database 40. There is, however, no teaching with Clare that discloses generating EAS data in an ALU based

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting Claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected Claim specified.

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upon an alarm event and alarm event information inputted by an user into the ALU. Therefore, Clare fails to identically disclose the Claimed invention, as recited in Claim 22, within the meaning of 35 U.S.C. § 102. For at least this reason, amended independent Claim 22 is believed patentable and the withdrawal of this rejection is respectfully requested.

Independent Claim 1

Similar to Claim 22, independent Claim 1 has been amended to recite that an EAS device receives an alarm event and generates EAS data based upon the alarm event and alarm event information. Also, the alarm event information is inputted by a user into an alarm event logging unit. As noted above with regard to Claim 22, Clare fails to disclose generating EAS data based upon an alarm event and alarm event information inputted by an user into an ALU. Therefore, Clare fails to identically disclose the claimed invention, as recited in amended Claim 1, within the meaning of 35 U.S.C. § 102.

The above argued differences between the method and system defined in independent Claims 1, 22 and 29 and the methodology and system of Clare undermine the factual determination that Clare identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed rejection of Claims 1-7, 9-11, 22-30, 33-34, and 36-44 under 35 U.S.C. § 102 for anticipation based upon Clare is not factually viable and, hence, solicit withdrawal thereof.

Claim 30 was rejected in paragraph 5 of the Office Action under 35 U.S.C. § 103 as obvious based upon Clare in view of Salim et al., U.S. Patent Publication No. 2004/0113791 ("Salim"). Page 6 of the Office Action concludes that one having ordinary skill in the art would

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have been motivated to modify the system of Clare in view of Salim to arrive at the claimed invention. This rejection is respectfully traversed.

With regard to the requisite motivation to modify Clare in view of Salim, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use both the product information and EAS information to generate the POS data for the purpose of enhancing accuracy.

The requisite motivation to modify a reference must be derived from the applied prior art. Salim, however, is silent as to "enhancing accuracy" by using both product information and EAS information to generate POS data. Moreover, both Salim and the Office Action have failed to explain how or why the system of Clare would enjoy enhanced accuracy based upon the teachings of Salim.

Given the lack of factual support within Salim for the Office Action's asserted motivation to modify Clare in view of Salim, Applicants can only conclude that the Examiner has engaged in impermissible hindsight reconstruction based upon Applicant's teachings so as to arrive at the Claimed invention. Since the Office Action has failed to assert a proper motivation to modify Clare in view of Salim, Applicants submit that the Office Action does not establish a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite realistic motivation. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of Claim 30 under 35 U.S.C. § 103 for obviousness based upon Clare in view of Salim.

In paragraph 6 of the Office Action, Claims 37-43 were rejected under 35 U.S.C. § 103 as obvious based upon Clare. The Office Action concludes that one having ordinary skill in the art

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would have been motivated to modify the system of Clare to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 37-43 depend ultimately from independent Claim 22, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of Claim 22 under 35 U.S.C. § 102 for anticipation based upon Clare. The Office Action fails to establish a motivation to modify Clare to arrive at the features not identically disclosed by Clare. Applicants, therefore, respectfully submit that the imposed rejection of Claims 37-43 under 35 U.S.C. § 103 for obviousness based upon Clare is not viable and, hence, solicit withdrawal thereof.

Claims 2-7, 9-11, 23-28, 30, 33, 34 and 36-44 are each dependent either directly or indirectly from one or another of independent Claims 1, 22 and 29, discussed above. These claims recite additional features which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable. However, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

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Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

CHARGE OUR DEPOSIT ACCOUNT

Please charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-1346.

Respectfully submitted,



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